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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,014	06/06/2006	Shuchong Pan	07039-409US1	9426
26191 7590 04/15/2008 FISH & RICHARDSON P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022				
EXAMINER				
WANG, CHANG YU				
ART UNIT		PAPER NUMBER		
1649				
MAIL DATE		DELIVERY MODE		
04/15/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/561,014

Applicant(s)

PAN ET AL.

Examiner

Chang-Yu Wang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-44 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I-XI, claim(s) 1-10, 16, 18, 19, drawn to polypeptides of SEQ ID NOs: 1-4, 16-20, 35 and 36, respectively.

Group XII-XIII, claim(s) 11-15, drawn to a DNA, a vector and host cells containing SEQ ID NO: 5 and 6, respectively.

Group XIV-XXIV, claim(s) 17, 39-44, drawn to antibodies against SEQ ID NOs: 1-4, 16-20, 35 and 36, respectively.

Group XXV-XXXV, claim(s) 20-31, drawn to a method of diagnosing a heart condition by detecting SEQ ID NOs: 1-4, 16-20, 35 and 36, respectively.

Group XXXVI-XLVI, claim(s) 32-38 (in part), drawn to a method of treating a heart condition by using polypeptides of BNP selected from SEQ ID NOs: 1-4, 16-20, 35 and 36, respectively.

Group XLVII-XLVIII, claim(s) 32-38 (in part), drawn to a method of treating a heart condition by gene therapy using the polynucleotides of SEQ ID NO:5 and 6, respectively.

2. The inventions listed as Groups I-XLVIII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Group I is directed to a polypeptide of SEQ ID NO:1, which is the first product. However, US Patent No. 6812339 (issued Nov 2, 2004, priority Sep 8, 2000, as in IDS) teach an

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isolated polypeptide comprising a sequence having 76.9% identity to a fragment of instant SEQ ID NO:1 (see sequence alignment below), which meets the limitation of "at least 65% sequence identity to a fragment of SEQ ID NO:1 at least six contiguous residues in length" as recited in claim 1. Thus, Group I does not have a special technical feature that defines a contribution over the prior art as defined by PCT Rule 13.2. Since the 1st claimed invention has no special technical feature, it cannot share a special technical feature with the other claimed inventions. Thus, Applicant's inventions have a single inventive concept and so lack unity of invention.

SEQ ID NO:1

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US-09-949-016-7086
; Sequence 7086, Application US/09949016
; Patent No. 6812339
; GENERAL INFORMATION:
; APPLICANT: VENTER, J. Craig et al.
; TITLE OF INVENTION: POLYMORPHISMS IN KNOWN GENES ASSOCIATED
; TITLE OF INVENTION: WITH HUMAN DISEASE, METHODS OF DETECTION AND USES THEREOF
; FILE REFERENCE: CLO01307
; CURRENT APPLICATION NUMBER: US/09/949,016
; CURRENT FILING DATE: 2000-04-14
; PRIOR APPLICATION NUMBER: 60/241,755
; PRIOR FILING DATE: 2000-10-20
; PRIOR APPLICATION NUMBER: 60/237,768
; PRIOR FILING DATE: 2000-10-03
; PRIOR APPLICATION NUMBER: 60/231,498
; PRIOR FILING DATE: 2000-09-08
; NUMBER OF SEQ ID NOS: 207012
; SOFTWARE: FastSEQ for Windows Version 4.0
; SEQ ID NO 7086
; LENGTH: 706
; TYPE: PRT
; ORGANISM: Human
US-09-949-016-7086

Query Match          30.4%; Score 56; DB 4; Length 706;
Best Local Similarity 76.9%; Pred. No. 36;
Matches 10; Conservative 0; Mismatches 3; Indels 0; Gaps 0;

Qy      5 LPPRPPSPVPCD 17
        ||||| | |||
Db      687 LPPRPPPPAPVND 699

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In addition, the technical features of Groups I-XI (polypeptides), XII-XIII (DNAs, vectors and host cells) and XIV-XXIV (antibodies) are drawn to structurally different products, which do not require each other for their practice and do not share the same or a corresponding technical feature. Groups XXV-XXXV are drawn to methods of

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diagnosing a heart condition, Groups XXXVI-XLVI are drawn to methods of treating a heart condition using polypeptides of BNP, and Groups XLVII-XLVIII are drawn to methods of treating a heart condition by gene therapy, which do not require each other for their practice and do not share the same technical feature. Note that PCT Rule 13 does not provide for multiple products or methods in a single application. Because the technical feature of Group I is not a special technical feature, and because the technical features of Groups II-XLVIII claims are not present in the Group I claims, unity of invention is lacking.

3. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). In order to be fully responsive, Applicant is required to elect a single group from designated groups I- XLVIII as set forth above to which the claims will be restricted, even though the requirement is traversed. The subject matter for examination will be restricted to the extent of the subject matter of the elected group.

4. The examiner has required restriction between product and process claims.

Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

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5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Any inquiry of a general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (571) 272-1600.

Papers relating to this application may be submitted to Technology Center 1600, Group 1649 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for Group 1600 is (571) 273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chang-Yu Wang whose telephone number is (571) 272-4521. The examiner can normally be reached on Monday-Thursday from 8:30 AM to 6:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Stucker, can be reached at (571) 272-0911.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Christine J Saoud/
Primary Examiner, Art Unit 1647

/CYW/
Chang-Yu Wang, Ph.D.
April 10, 2008